

REMARKS

This paper responds to the Final Office Action mailed on December 4, 2008. Claims 2, 6, 14, 18, 23-24 and 28 are amended; claims 8, 20, 30 and 37-38 were previously canceled; no claims are added; as a result claims 1-7, 9-19, 21-29, 31-36, and 39-41 are pending in this application.

§112 Rejection of the Claims

Claims 2, 14 and 24 were rejected under 35 U.S.C. § 112, second paragraph, as having insufficient antecedent basis for the limitation “user.” Applicants amend these claims and claims 6, 18 and 28 to replace -- user -- with “seller,” consistent with the previously presented amendments to the independent claims. Applicants respectfully request withdrawal of this rejection.

§103 Rejection of the Claims

Claims 1-4, 7, 9, 13-16, 19, 21, 23-26, 29, 31, 35 and 37-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. (U.S. Publication No. US2003/0036964 A1, hereinafter “Boyden”) in view of Raines (U.S. Patent No. 7,228,298, hereinafter “Raines”). Applicants respectfully traverse these rejections.

Applicants respectfully submit that the rejection of the aforementioned claims under 35 U.S.C. § 103 is defective for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

Applicable Law

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. §2142. In the recent decision of the Supreme Court on *KSR Int'l Co. v. Teleflex Inc.*¹, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*², was reaffirmed.

¹ 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

² 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

The Court in *Graham* set out an objective analysis for applying §103 as follows:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”³

When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*⁴. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*⁵. Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*⁶. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*⁷. Office personnel must rely on the Applicant’s disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*⁸.

With respect to the pending independent claims, and specifically with respect to claim 1, the claims are directed to *generating a listing in a network-based commerce system*. While the Boyden teaches a network-based commerce system for valuating vehicles, there is no teaching or suggesting of generating a listing as recited in Applicants’ claims. Boyden provides a procedure for sellers to add and track vehicles on an auction database, as described by Figures 2A-2J.⁹ A seller can input information into the form provided, and the input information is augmented with valuation information from a database. In contrast to Boyden, Applicants’ claims recite a method for generating a listing, comprising *receiving listing identification data from a seller*. In Boyden, the seller inputs vehicle information, but does not input *listing identification data*.

³ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

⁴ 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

⁵ 383 U.S. 1 at 467.

⁶ 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁷ 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

⁸ 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff’d*, U.S., 116 S. Ct. 1384 (1996).

⁹ Boyden, paragraph [0028].

Continuing with Applicants' claim 1, the method searches *a database of listing data ... to locate a plurality of similar listings*. Applicants' respectfully disagree with the characterization of Figure 2A of Boyden as teaching this limitation, as the search tool 204 is used to search for specific products, by VIN or other criteria, and is not used to locate *similar listings*.

Further, claim 1 recites *receiving an indication from the seller selecting a selected listing from the plurality of similar listings*. There is no teaching of receiving such an indication from the seller in Boyden. The portion of Boyden identified by the Examiner refers to a selection by a buyer not a seller. Figures 3A-3K of Boyden illustrate pages displayed to the buyer. The Boyden reference specifically teaches away from Applicants' claimed invention, as the seller merely inputs information into a database, whereupon the data is available for retrieval by a buyer, but the presentation of the data to the buyer is preformatted by the auction system. There is no need for a seller to see a proposed listing, as the seller cannot *modify the listing data in the proposed listing to create the listing*, as required by claim 1. Indeed, the seller may only *see* the vehicle information as input into the database. In fact, even that information may be overwritten by verified valuation information available to the auction system.¹⁰

Further, claim 1 recites *generating proposed listing to present to the seller*. Boyden does not teach a system that presents a proposed listing to the seller. Applicants respectfully disagree with the characterization of Boyden as teaching a proposed listing in Figure 2B, and paragraph [0032], as Figure 2B is merely one of several seller worksheets to input information. As stated in Boyden, the Figure "illustrates an example of a vehicle worksheet page 200b to modify data."

¹¹ The input information is then stored in a database to be searched by buyers. While this information may be used to generate a listing, this worksheet is not a *proposed listing*, as required by claim 1. This is clearly seen by considering Boyden's Figures 3A-3K, which are the resultant web pages presented to the buyer. These web pages are not presented to the seller. As these pages are not presented to the seller, the seller is not allowed to *modify the listing data in the proposed listing*.

¹⁰ Ibid., paragraph [0026].

¹¹ Ibid., paragraph [0032].

Raines

The deficiencies of Boyden are not satisfied by Raines. Raines discusses searching for vehicle and presenting the search results, but does not disclose *generating a proposed listing*, as recited in Applicants' claims. Therefore, the combination of Boyden and Raines fails to support a *prima facie* case of obviousness.

Independent claims 13, and 23 include the limitations identified above with respect to claim 1.

Applicants respectfully submit the independent claims, and claims depending thereon, are patentable over the applied references and respectfully requests reconsideration and allowance of the claims pending in this application.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have equally addressed every assertion made in the Final Office Action, however, this does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of

the present patent application, and to request joinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 373-6900 or the undersigned to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402

Date February 4, 2009

By

Sandra L. Godsey

Sandra L. Godsey
Reg. No. 42,589

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4 day of ~~February~~ FEBRUARY, 2009 28

Name

CHRIS BARTON

Signature

Chris Barton